

### **REMARKS**

On February 20, 2004, the Examiner issued a Non-Final Office Action in connection with the above-referenced matter. In the Office Action, the Examiner: (i) rejects claims 4, 13, 15 –17, 21, 23, 24, 26, 29 –32, 36, 38, 40 and 41 under 35 U.S.C. § 112; (ii) rejects claim 42 under 35 U.S.C. § 102(b) as being anticipated by Katamoto '378; (iii) objects to claim 27; and (iv) allows claims 1 – 3, 5, 12, 14, 18 – 20, 22, 25, 28, 33 – 35, 37 and 39, indicating that claims 1 –41 are free of prior art. Applicants respond to the rejections and objection as follows:

#### **Response to rejection of claims 4, 13, 15 –17, 21, 23, 24, 26, 29 –32, 36, 38, 40 and 41 under 35 U.S.C. § 112**

The Examiner rejects certain claims asserting that they do not comply with 35 U.S.C. § 112 for various reasons. Applicants express no opinion as to the merits of the rejections, but have amended the claim set as indicated above. As the Examiner has noted, the subject matter of all of claims 1 –41 are free of prior art. Thus, Applicants amend the claim set without surrendering any subject matter of the originally filed claims.

Applicants have amended claim 4, deleting the phrase “and oxychlorides” and added new claim 43 directed to the oxychlorides of the Markush group of claim 4. Thus, Applicants have removed one of the occurrences of “and” from the claim.

Applicants have amended claim 13 to delete the phrase “step of” and thereby provide proper antecedent basis for “said isolating” since claim 12 specifically references “isolating.”

Applicants have amended claim 15 to provide that the sulfate containing compound is added “to said metal hydroxide-containing precipitate and said calcium chloride containing liquid phase of step (b).” Support for this amendment may, for example, be found on lines 16 –20 of the Specification.

Applicants have amended claim 16 by rewriting it in independent form with the steps of (a)

– (e) of claim 14, and indicating that the sulfate-containing compound is added to the liquid phase of step (e). Support for this claim may be found on page 18, line 22 to page 23, line 16 of the Specification and in originally filed claims 14 and 16.

Applicants have canceled claim 17.

Applicants have amended claim 21 in the same manner as they have amended claim 4, and have added new claim 44 directed to the oxychlorides of the Markush group.

Applicants have amended claim 23 as the Examiner suggested to refer to said first slurry stream as opposed to the liquid slurry.

Applicants have amended claim 24 to provide that the percentages are weight percentages. When referring to amounts of iron oxides, one skilled in the art would refer to them by weight percentage, as is done in the disclosure. *See e.g.*, Specification page 2, lines 13, 22 -23; page 4, line 7; page 27, line 14.

Applicants have amended claim 26 to add the term “phase” to “said residual liquid,” which appears in step (f) of claim 14, thereby providing proper antecedent basis.

Applicants have amended claim 29 to provide that the sulfate-containing compound is added to said first precipitate and said first liquid phase. Support for this amendment may, for example, be found on page 25, lines 4 –15 of the Specification.

Applicants have amended claim 30 to provide that the sulfate-containing compound is added to the second solution. Support for this amendment may, for example, be found on figure 3 and page 26, lines 14 –23 of the Specification.

Applicants have amended claim 31 by rewriting it in independent form, incorporating the steps of (a) – (e) of claim 28.

Applicants have amended claim 32 to provide that it is directed to adding a sulfate-containing compound to the metal hydroxide-containing compound and calcium chloride containing liquid phase. Support for this amendment may, for example, be found on page 25, lines 11 –15 of the Specification.

Applicants have amended claim 36 to remove the phrase “and oxychlorides” and one of the other occurrences of “and.” Applicants have also deleted references to uranium, thorium and tin. Further, Applicants have added new claim 45 directed to the oxychlorides of the Markush group.

Applicants have amended claim 38 as the Examiner suggests to refer the to the liquid slurry stream.

Applicants have amended claim 40 to refer to said residual liquid phase, and have amended claim 28 on which claim 40 depends to provide proper antecedent basis.

Applicants have amended claim 41 to remove the phrase “step of” and have amended claim 28 to provide proper antecedent basis for “said residual liquid phase.” Applicants have also amended claim 41 to depend on claim 40.

Applicants have also reformatted the letter denotations of claims with subparts in order to be consistent, for example changing “a.” to (a) in claims 1 and 14, and deleted the phrase “step of” in claim 27.

With respect to all of the amendments above, no new matter has been added.

#### **Response to rejection of claim 42 under 35 U.S.C. § 102(b)**

The Examiner rejects claim 42 under 35 U.S.C. § 102(b) over Katamoto. Applicants express no opinion as to the merits of the Examiner’s rejection, but have, in the interest of

furthering prosecution canceled the claim.


**Response to objection to claim 27**

The Examiner objects to claim 27. Applicants have amended the claim on which claim 27 depends (claim 26) in order to overcome the outstanding objection. Therefore, Applicants submit that this objection is moot.

Based on the foregoing, Applicants respectfully submit that the outstanding rejections and objection should be withdrawn.

As provided above, Applicants have canceled one dependent claim and one independent claim, converted two dependent claims into independent claims, and added three dependent claims. Applicants enclose a check of \$122 to cover the net increase of claims, as well as the petition for extension of time. If any additional fee is due or an overpayment has been made, the Patent Office is hereby authorized to charge or to credit Deposit Account No. 11-0171 for such sum accordingly.

Respectfully submitted,  
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